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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,593	12/17/1998	JEFFREY M. GROSS	02939-P0001A	7204

7590 08/20/2002

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EXAMINER

SINGH, RACHNA

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/215,593

Applicant(s)

GROSS ET AL.

Examiner

Rachna Singh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This action is responsive to communications: application, filed 12/17/98;
2. Claims 1-22 are pending in the case. Claims 1, 10, 17, and 22 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plantz et al., US Patent Number: 6,088,702, 7/00 (filed 2/98) and further in view of Smith et al., US Patent Number: 5,790,790, 8/1998, Aoyama et al., US Patent Number: 6,301,592, 10/01 (filed 11/98), Ogawa, US Patent Number: 5,438,661, 8/95 and Adobe Acrobat Review, Available: <http://www.desktoppublishing.com/reviews/acrobat-1.html>, Adobe Acrobat 3.0, 1993

Independent Claim 1 cites; ***"a system for proofing electronic documents delivered over a network comprising:  
a plurality of electronic documents in portable document file format;  
a computer connectable to the network for receiving the plurality of portable format documents together with at least one associated proofer identifier;  
a program executing on said computer for assigning a version number to each of the plurality of received portable format documents;***

***and a database accessible by said computer for storing the documents and associated version numbers;***  
***said computer for receiving a request, from a proofer presenting the proofer identifier, to review multiple versions of a portable format electronic document;***  
***said program for retrieving and formatting the requested multiple document versions for simultaneous display to permit visual comparison."***

Smith discloses a system for delivering a portable document format to a server. See abstract. While Smith's system does not disclose a means with which the electronic documents can be proofed; Plantz does. Plantz discloses a group publishing system in which an unlimited number of authors and editors can perform word processing, document assembling, and editing functions on various portions of the document in a project. See abstract. His computer-based publishing system is implemented over the Internet. See column 7, lines 11-15. Plantz system also provides access control to prevent unauthorized persons from accessing and making changes to documents and projects. They do this using an identifier. See column 7, lines 30-35. Upon identifying the user, the system allows the user to edit documents in the project. See column 7, lines 35-62. Plantz system outputs the document into a viewable, printable, or downloadable in publishable format. See abstract. Both Plantz and Smith are of analogous art in the field of document processing.

Plantz does not disclose a system in which the program assigns a version number to the document that has been modified; however Aoyama does. Aoyama discloses a system for displaying version information. His system of version

management consists of assigning a version number to the document. Moreover, it provides storage for the version information. See column 1, lines 39-44 and figures 1, 2 and 6. Aoyama also teaches presenting the versions of a document in a two-dimension display in which elements of the project are displayed with versions of the elements. Specifically, Aoyama discloses a means to display the various version elements so that a user can see the relationship between a particular version of a project and constituent elements of particular versions thus resulting in the efficiency of project editing. Aoyama does not disclose a visual comparison of the various versions, but Ogawa teaches a means in which a version of a document is displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process.

It would have been obvious to combine Aoyama and Ogawa since both are concerned with editing documents and providing the various versions to the user for displaying a relationship between the documents. Simultaneously displaying the documents allows for ease of editing and reduced buffer area in a version editing environment as taught by Ogawa. It would have been obvious to incorporate Plantz's system of editing documents with a proofer identifier with Aoyama's system of version management and Ogawa's simultaneous display because the user is editing a document to be retrieved by other editors. Since they are collaborating on editing a document or project, it would make sense to provide version information along with information on the user who edited the document as taught by Aoyama with a proofer

identifier to make sure no unauthorized users are editing the documents. Moreover, Plantz, Aoyama, and Ogawa are concerned with editing documents and providing different versions of these documents. Thus combining Plantz, Aoyama, and Ogawa would make sense since both systems have similar goals in providing the user with the ability to edit documents.

While both Plantz and Aoyama do not disclose a system in which the documents being edited are portable document file formats, Adobe Acrobat 3.0 allows users to edit a portable document file. More specifically, Acrobat consists of an Exchange feature which allows a user to insert, delete and edit portions of the document. It would have been obvious to combine Acrobat's feature of editing portable document files with Smith's method of delivering a portable document over a network in order to provide an environment in which multiple users could edit documents of multiple versions since it was common at the time the invention was made to collaboratively edit documents in a project over a network.

Claim 2 further cites, ***"in which the network is the internet."*** Plantz discloses a system in which the network is the Internet. See column 7, lines 11-15.

Claim 3 further cites, ***"in which said program sends an email each time a new document version is received, notifying the proofer that it is available for review."*** Plantz's system allows editors to electronically communicate with each other; however, Plantz does not disclose a system in which a program sends an email each time a new document version is received. See abstract. Smith's document delivery system allows the publisher to deliver documents to the consumers via email. Smith also discloses a

system in which notification is sent to the receiver upon the retrieval of a document on the server. See abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a notification program which delivers an email to the editors upon the receipt of a new document since it allows the user to see new versions.

Claim 4 cites, ***"the system of claim 2 in which said computer includes a webserver program for publishing document versions to proofers."*** Plantz's system allows the proofer to view the published versions on a webserver program such as Internet Explorer. See column 7, lines 15-25 and Figure 6.

Claim 5 further cites, ***"in which said computer executes scripts permitting the proofer to request information from said database through the web-server program."*** Plantz's system uses an Internet connection and a web-server program to allow the editor to link to a URL of a site and view, edit, and share the documents. See column 7, lines 10-27.

Claim 6 cites, ***"in which said computer executes scripts which interpret commands entered by the proofer."*** Plantz system allows the editor to make changes in the documents. See column 7, lines 28-63.

Claim 7 cites, ***"in which said computer receives comments from proofers concerning document versions, and in which said program stores the comments in said database together with the corresponding document version."*** Plantz discloses a system in which the notes and messages from the authors and editors are posted. While Plantz does not disclose this information in reference to the document

versions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of editor comments to display them along with the version information display as disclosed by Aoyama since it allows the editors to see other views of corresponding editors in regards to various versions of the document.

Claim 8 further cites, ***“in which said computer formats a history of received comments for display together with a document version.”*** While Plantz discloses a means of receiving comments from the editors, he does not disclose a method of formatting a *history* of the comments related to the versions disclosed by Aoyama. Aoyama, however, does include dates for each version of the documents in a project. It would have been obvious to one of ordinary skill in the art at the time the invention was made to organize Plantz’s comments in a historical manner in regards to the various versions of a document because the version information includes the date of editing and linking the comment to an appropriate version aids the editors in receiving feedback from their collaborators.

Claim 9 cites, ***“wherein said program retrieves records corresponding to each of the requested document versions and assembles URLs pointing toward the documents from data in the records.”*** Aoyama discloses a means of retrieving various versions of a document; however, Aoyama does not disclose a program for assembling URLs pointing to the documents from data in the records. Plantz does disclose his system of editing documents to take place over the Internet. Access to a project is obtained by linking to an URL. It would have made sense to one of ordinary skill in the art at the time the invention was made to incorporate Aoyama's version



information display with Plantz's linking to a URL for the project documents since providing editing options over the Internet allows users of various localities to access the documents at their convenience.

In reference to Claim 10, Plantz discloses a system in which the notes and messages from the authors and editors are posted. While Plantz does not disclose this information in reference to the document versions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of editor comments to display them along with the version information display as disclosed by Ogawa since it allows the editors to see other views of corresponding editors in regards to various versions of the document. Plantz displays the comments using a web board. See column 11, lines 12-15. Ogawa teaches a means in which various versions of the documents are displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process. See rejections above. Both displaying notes and messages from the editors and a simultaneous display of different versions were well known in the art at the time of the invention, thus displaying both pieces of information simultaneously would have been obvious to one of ordinary skill in the art since the comments refer to the various versions of the documents. The rest of claim 10 is rejected under the same rationale used in claim 1 above.

Claim 11 further cites, ***"in which at least some of the plurality of comments are received by said computer together with a proofer identifier."*** Plantz system posts the comments with the editor name. See column 11, lines 10-15.

Claim 12 cites, ***"in which at least some of the plurality of comments are received by said computer together with a creator identifier."*** Plantz system can also post the comments with the author names. See column 11, lines 10-15.

In reference to claim 13, Plantz discloses his system over the Internet.

Claim 14 rejected under same rationale used to reject claim 3 above.

In reference to claim 15, Plantz displays the comments using a web board. See column 11, lines 12-15. Aoyama discloses a system for displaying version information. Thus displaying both pieces of information simultaneously would have been obvious to one of ordinary skill in the art since the comments refer to the various versions of the documents.

Claim 16 rejected under the same rationale used to reject claim 9 above.

In reference to claim 17, Smith discloses a system for delivering a portable document format to a server. See abstract. While Smith's system does not disclose a means with which the electronic documents can be proofed; Plantz does. Plantz discloses a group publishing system in which an unlimited number of authors and editors can perform word processing, document assembling, and editing functions on various portions of the document in a project. See abstract. His computer-based publishing system is implemented over the Internet. See column 7, lines 11-15. Plantz system also provides access control to prevent unauthorized persons from accessing

and making changes to documents and projects. They do this using an identifier. See column 7, lines 30-35. Upon identifying the user, the system allows the user to edit documents in the project. See column 7, lines 35-62. Plantz system outputs the document into a viewable, printable, or downloadable in publishable format. See abstract. Both Plantz and Smith are of analogous art in the field of document processing.

Plantz does not disclose a system in which the program assigns a version number to the document that has been modified; however Aoyama does. Aoyama discloses a system for displaying version information. His system of version management consists of assigning a version number to the document. Moreover, it provides storage for the version information. See column 1, lines 39-44 and figures 1, 2 and 6. Aoyama discloses a version information system in which the user can choose a document among the various versions in a project. See figure 6 and column 2, lines 55-60. The user can select which one to view. See figure 6. Aoyama also teaches presenting the versions of a document in a two-dimension display in which elements of the project are displayed with versions of the elements. Specifically, Aoyama discloses a means to display the various version elements so that a user can see the relationship between a particular version of a project and constituent elements of particular versions thus resulting in the efficiency of project editing. Aoyama does not disclose a visual comparison of the various versions, but Ogawa teaches a means in which a version of a document is displayed on the same display screen for comparison. See abstract and

columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process.

It would have been obvious to combine Aoyama and Ogawa since both are concerned with editing documents and providing the various versions to the user for displaying a relationship between the documents. Simultaneously displaying the documents allows for ease of editing and reduced buffer area in a version editing environment as taught by Ogawa. It would have been obvious to incorporate Plantz's system of editing documents with a proofer identifier with Aoyama's system of version management and Ogawa's simultaneous display because the user is editing a document to be retrieved by other editors. Since they are collaborating on editing a document or project, it would make sense to provide version information along with information on the user who edited the document as taught by Aoyama with a proofer identifier to make sure no unauthorized users are editing the documents. Moreover, Plantz, Aoyama, and Ogawa are concerned with editing documents and providing different versions of these documents. Thus combining Plantz, Aoyama, and Ogawa would make sense since both systems have similar goals in providing the user with the ability to edit documents.

While both Plantz and Aoyama do not disclose a system in which the documents being edited are portable document file formats, Adobe Acrobat 3.0 allows users to edit a portable document file. More specifically, Acrobat consists of an Exchange feature which allows a user to insert, delete and edit portions of the document. It would have been obvious to combine Acrobat's feature of editing portable document files with

Smith's method of delivering a portable document over a network in order to provide an environment in which multiple users could edit documents of multiple versions since it was common at the time the invention was made to collaboratively edit documents in a project over a network.

Claim 19 is rejected with the same rationale used to reject claim 7 above.

Claim 20 is rejected with the same rationale used to reject claim 8 above.

In reference to claim 21, Plantz discloses the system over the Internet. See column 7, lines 11-15. Plantz also discloses the use of a web server program such as Internet Explorer. See column 7, line 15-20.

Claim 22 is rejected under the same rationale used in claim 17 above.

### ***Response to Arguments***

5. Applicant argues that the '702 patent, '592 patent, '792 patent and Adobe Review reference do not disclose the ability to simultaneously display multiple versions of an edited document for visual comparison as required by claims 1 and 22 and amended claim 17. Ogawa teaches a means in which a version of a document is displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process. See rejections above.

Applicant argues with regard to claim 10 that none of the cited prior art references disclose "formatting the requested document together with the associated plurality of comments for simultaneous display to permit review". However, Plantz discloses a system in which the notes and messages from the authors and editors are

posted. While Plantz does not disclose this information in reference to the document versions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of editor comments to display them along with the version information display as disclosed by Ogawa since it allows the editors to see other views of corresponding editors in regards to various versions of the document. Plantz displays the comments using a web board. See column 11, lines 12-15. Ogawa teaches a means in which various versions of the documents are displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process. See rejections above. Both displaying notes and messages from the editors and a simultaneous display of different versions were well known in the art at the time of the invention, thus displaying both pieces of information simultaneously would have been obvious to one of ordinary skill in the art since the comments refer to the various versions of the documents

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Number 6,065,026      Cornelia et al.      707/531

Multi-User Electronic Document Authoring System With Prompted Updating of Shared Language

US Patent Number 6,349,287      Hayashi      705/8

Work-Flow Support System

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh at 703.305.1952. The examiner can normally be reached on Monday-Friday from 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at 703.308.5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703.305.3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Application/Control Number: 09/215,593

Page 15

Art Unit: 2176

**or faxed to:**

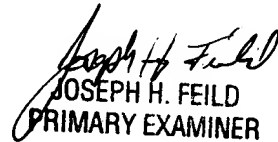
**After-Final 703.746.7238**

**Official 703.746.7239**

**Non-Official/Draft 703.746.7240**

Hand-Delivered responses should be brought to Crystal park II, 2121 Crystal Drive, Arlington VA., Sixth Floor (Receptionist).

Rachna Singh  
August 15, 2002

  
JOSEPH H. FEILD  
PRIMARY EXAMINER